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GARMIN LTD.
C/O GARMIN INTERNATIONAL, INC.
ATTN: Legal - IP
1200 EAST 151ST STREET
OLATHE, KS 66062

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ORTIZ, BELIX M	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MATTHEW C. BURCH

Appeal 2008-005089
Application 10/071,560
Technology Center 2100

Decided: May 25, 2010

Before LEE E. BARRETT, JOSEPH L. DIXON, and JAY P. LUCAS, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-45. The Appellant appeals therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

A. INVENTION

The invention at issue on appeal is related to:

> Systems, devices and methods are provided for selecting a desired track log from a set of track log points so as to provide electronic systems, such as navigational aid devices, with the capability of more powerful and flexible applications. In one embodiment [claim 1], a desired first endpoint and a desired second endpoint are specified for a desired track log. An actual first endpoint is assigned based on the desired first endpoint and a set of track log points. An actual second endpoint is assigned based on the desired second endpoint and the set of track log points. The desired track log is identified using the actual first endpoint, the actual second endpoint, and at least one track log point. At least one of the desired first endpoint and the desired second endpoint is capable of being specified by specifying a location.

(Abstract).

> In one electronic device application that uses this data structure, the data structure 216 associates a position of the electronic device, such as device 110 in Figure 1, with a time at which the electronic device is at the position. The data structure 216 also includes a field that represents a segment start point flag 226, which identifies whether the track log point is a start point of a previously recorded segment of a track log. A desired track log is capable of being determined or identified by using two track log points that are flagged as segment start points, and at least some of the track log points that extend between the two segment start points. A segment start point, as used herein, represents the first point recorded since the last satellite fix acquired. Segment start points are capable of serving as a way of locating various subset of an active track log, such as one trip within a series of recorded trips.

(Spec. 7).

B. ILLUSTRATIVE CLAIM

Claim 1, which further illustrates the invention, follows.

1. A method, comprising:

specifying a desired first endpoint and a desired second endpoint for a desired track log;

assigning an actual first endpoint for the track log based on the desired first endpoint and a set of track log points, and an actual second endpoint for the track log based on the desired second endpoint and the set of track log points; and

identifying the desired track log using the actual first endpoint, the actual second endpoint, and at least one track log point,

wherein at least one of the desired first endpoint and the desired second endpoint is capable of being specified by specifying a location.

C. REJECTION

Claims 1-45 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Ran (U.S. Patent 6,317,686, Nov. 13, 2001).

II. ISSUE

Has the Examiner erred in finding Ran anticipates the invention as recited in independent claim 1? Specifically, does Ran teach "track logs"?

III. PRINCIPLES OF LAW

Standard of review

The Examiner has the initial burden to set forth the basis for any rejection so as to put the patent applicant on notice of the reasons why the

applicant is not entitled to a patent on the claim scope that he seeks – the so-called "*prima facie case*." *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). An appellant may attempt to overcome an examiner's rejection on appeal to the Board by submitting arguments and/or evidence to show that the examiner made an error in either (1) an underlying finding of fact upon which the final conclusion was based, or (2) the reasoning used to reach the legal conclusion. *See Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential). The panel then reviews the rejection for error based upon the issues identified by appellant, and in light of the arguments and evidence produced thereon. *See Oetiker*, 977 F.2d at 1445; *See also Frye*, 94 USPQ2d at 1075.

CLAIM GROUPING

37 C.F.R. § 41.37(c)(1)(vii) follows in pertinent part.

> When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately.

IV. ANALYSIS

At the outset, we note that Appellant does not follow the proper procedures set forth by 37 C.F.R. § 41.37 of using subheadings for proper identification and grouping of the claims. We will attempt to group Appellant's claims as listed throughout the arguments.

Independent claim 1

From our review of Appellant's arguments we find Appellant repeatedly relied upon the definition of "track logs," "as described in the specification and claimed in the claims." Yet, Appellant never specifically and expressly identifies where this definition is set forth. In the Summary of the Claimed Invention in the Appeal Brief (pages 2-3) and Reply Brief (page 2), Appellant paraphrases a portion of the Background of the Invention section of the Specification which generally discusses "track logs" as they are used in navigational aid devices, comparing a track log to an "electronic version of Hansel and Gretel's bread crumb trail."

Appellant's main argument throughout both the Appeal Brief and Reply Brief is based on the distinction between the "track log" of the claimed invention and the Examiner's proffered teaching of a track log in the teachings of Ran. At pages 8 and 9 of the Appeal Brief, Appellant provides three definitions of "log," which "all include terms such as 'a ship', 'an aircraft', 'a ship's voyage', 'a flight by an aircraft', and 'a trip'. Thus, a log is a collection of specific record entries of a specific vehicle, rather than simply some average or other aggregation of travel times."

We find Appellant's arguments to be strained and not based upon express definitions in the Specification. Furthermore, Appellant's discussion at page 9 of the Appeal Brief states that "[a]ppellants also note that the page and line numbers cited above are for reference purposes only and should not be taken as a limitation on the support for, or scope of, the claimed subject matter." We find Appellant is trying to limit any inferred limitations, yet attempting to distinguish the teachings of Ran. We

additionally find the proffered definitions do not have any corresponding dates to identify the definitions relative to be instant filing date. Furthermore, Appellant's proffered definitions all refer to a "vehicle" of some sort which is not found in the instant claimed invention nor do we find a (magical) "black box" which performs the recited functions in independent claim 1. Therefore, we find Appellant's urgings with respect to the interpretation of "track log" to go well beyond the express language of the claim and well beyond any express definition not specifically identified in the Specification, and Appellant has provided no extrinsic evidence showing a definition of "track log." Therefore, we find the Examiner's presentation of the showing of anticipation based upon Ran to be acceptable and Appellant has not shown error therein.

Appellant's proffered distinction between the prediction in Ran and the track logs in the claimed invention is not based upon the express claim language or an express definition in the Specification or a clear interpretation of the claim language. (App. Br. 10-11). Appellant's urgings require us to read substantive limitations into the claims to distinguish between the teachings of Ran and the claimed invention. This we cannot do. While a "log" may be historical data, we find that Ran teaches historical data, yet it is not with a specific vehicle or specific unit or device. These limitations are not recited in the language of independent claim 1. Therefore, arguments thereto cannot distinguish over Ran. Each time Appellant refers to "track logs" throughout the Appeal Brief and Reply Brief, in an attempt to distinguish over the teachings of Ran, Appellant does not cite to a specific express definition of "track logs." Therefore, Appellant's argument is not well supported.

Appellant contends that the traffic data taught by Ran "can only reflect an average of numerous trips involving numerous anonymous vehicles and therefore cannot 'provide an indication of where a specific device has been', as the present specification defines track logs." (App. Br. 11). Here again, Appellant tries to import limitations of a "device" which is not specifically recited in the generic "method."

Appellant further argues that "rather than any specific discrete time or historical time period, Ran is strictly concerned with elapsed travel times between two points." (App. Br. 11). Again, Appellant's proffered distinction goes beyond the express claim language and is therefore not persuasive of error in the Examiner's showing of anticipation.

Appellant argues, "[i] n no way does Ran seek to select a specific track log, which documents a specific device's travel between specific points over a specific time period. Since Ran does not teach track logs or selecting individual track logs, Ran simply cannot anticipate the method of doing so." (App. Br. 11). Again, Appellant's proffered distinction goes beyond the express claim language and is therefore not persuasive of error in the Examiner's showing of anticipation.

Appellant reiterates the limitations of independent claim 1, which Appellant contends Ran "simply does not anticipate." Thus, it is our view that Appellant has made a general allegation in the Appeal Brief that the above-mentioned claim defines a patentable invention without specifically pointing out how the language of the claim patentably distinguishes over the cited reference. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. *See* 37 C.F.R. § 41.37(c)(1)(vii). We find Appellant's appeal is based on a

series of conclusory arguments presented in the Brief. This form of argument is ineffective in establishing the patentability of the claims on appeal. *See Ex parte Belinne*, No. 2009-004693, slip op. at 7-8 (BPAI Aug. 10, 2009) (informative).

Other claims

With respect to independent claims 14 and 39, Appellant repeats the language of the claims and maintains that Ran simply does not anticipate track logs much less discrete track log points and other limitations. (App. Br. 13-14; Reply Br 6-7). We find Appellant's general allegation unpersuasive of error in the Examiner's showing of anticipation. Therefore, we will group independent claims 14 and 39 with independent claim 1.

With respect to dependent claims 2 and 20, Appellant repeats the language of the claims and maintains that Ran simply does not anticipate the limitations. (App. Br. 14; Reply Br 7). We find Appellant's general allegation unpersuasive of error in the Examiner's showing of anticipation. Therefore, we will treat dependent claims 2 and 20 as standing or falling with independent claim 1.

With respect to independent claims 22 and 31, Appellant repeats the language of the claims and maintains that Ran simply does not anticipate the limitations. (App. Br. 14; Reply Br 7). We find Appellant's general allegation unpersuasive of error in the Examiner's showing of anticipation. Therefore, we will group independent claims 22 and 31 with independent claim 1.

With respect to dependent claims 3 and 21, Appellant repeats the language of the claims and maintains that Ran simply does not anticipate the

limitations. (App. Br. 14-15; Reply Br 7-9). Appellant offers an "example," but does not identify any definition for the claimed "filtering" with which to distinguish over the teachings of Ran. We find Appellant's "example" to be not commensurate in scope and unpersuasive to the instant claimed invention. Therefore, we will group dependent claims 3 and 21 with independent claim 1.

With respect to dependent claim 4, Appellant argues that Ran simply does not teach "identifying a time associated with the nearest track log point" as claimed. Appellant contends that the claim language as described in the Specification and used in the claims, refers to the time that a device was actually at a position associated with the track log point. (App. Br. 15; Reply Br. 9). Appellant contrasts the teachings of Ran as only interested in the elapsed time between points rather than any specific time a device was at a specific point and concludes that Ran does not anticipate the "searching for the nearest track log point" limitation. (App. Br. 16; Reply Br. 9). We find Appellant's argument is not supported by the express language of dependent claim 4 wherein a "device" is not expressly set forth in dependent claim 4 or in independent claim 1. Similarly, Appellant's reliance upon a "specific time" and a "specific location" may be deemed to be different than the claimed "specified location" and "a time." We find Appellant's arguments to not be commensurate in scope with the express language of dependent claim 4. Therefore, we will group dependent claim 4 with independent claim 1.

With respect to independent claim 10, Appellant repeats the language of the claim and maintains that Ran simply does not anticipate track logs much less discrete times associated therewith. (App. Br. 16; Reply Br 9-10).

We find Appellant's general allegation unpersuasive of error in the Examiner's showing of anticipation. Therefore, we will group independent claim 10 with independent claim 1.

With respect to dependent claims 11-13, 36, and 38, Appellant repeats the language of the claims and maintains that Ran simply does not anticipate the limitations. (App. Br. 16-17; Reply Br 10). We find Appellant's general allegation unpersuasive of error in the Examiner's showing of anticipation. Therefore, we will group dependent claims 11-13, 36, and 38 with independent claim 1.

Appellant has not presented separate arguments for patentability of claims 5-9, 15-19, 23-30, 32-35, 37, and 40-45. We sustain the rejection thereof and group them with independent claim 1.

V. CONCLUSION

For the aforementioned reasons, we find that the Examiner has not erred in a showing of anticipation of independent claim 1. Appellant has not presented persuasive arguments with respect to claims 2-45 which fall with independent claim 1.

VI. DECISION

We affirm the anticipation rejection of claims 1-45 under 35 U.S.C. § 102(e).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(iv). *See* 37 C.F.R. § 41.50(f).

AFFIRMED

msc

GARMIN LTD.
C/O GARMIN INTERNATIONAL, INC.
ATTN: Legal – IP
1200 EAST 151ST STREET
OLATHE, KS 66062